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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

In re Application of:
Van Gompel, et al
Serial No. 10/624,660
Filed: July 22, 2003

Title: **DISPOSABLE UNDERGARMENT
HAVING A CUTOUT AND METHOD
FOR THE MANUFACTURE
THEREOF**

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is responsive to the petition filed on July 26, 2007 by which petitioners request supervisory review of the restriction requirement of claims 2-7, 10-16 and 28-33 rendered in paper No. 20070319 mailed March 27, 2007 in a Final Rejection, traversed by petitioners on June 04, 2007. The petition is considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is **GRANTED**.

The record shows that:

1) On June 08, 2006, the Examiner rendered a Non-Final Office action (paper No. 20060527) rejecting originally filed claims 1-16 and 28-31 in response to a previously filed restriction/election requirement. On December 06, 2006, the Examiner rendered a second written restriction requirement between nine different species with a brief explanation of the particulars of each of the species. On January 08, 2007, Applicant elected to prosecute Specie G with the indication that claims 1-8, 10-16 and 28-33 were either generic with respect to, or read on specie G. On March 27, 2007, the Examiner rendered a Final Office Action considering only claims 1 and 8 (paper No. 20070319). On April 11, 2007, Applicant initiated a telephone interview with the Examiner to discuss the decision not to examine claims 2-7, 10-16 and 28-33. On June 6, 2007, Applicants traversed the restriction requirement and the withdrawal of claims 2-7, 10-16 and 28-33 from consideration in an amendment after final following the Examiner's agreement and suggestion during the interview. On June 28, 2007, the Examiner rendered a final decision in an Advisory Action refusing to consider claims 2-7, 10-16 and 28-33. On July 07, 2007, applicant responded by filing a Request for Continued Examination (RCE).

The Examiner's rationale for holding claims 2-7, 10-16 and 28-33 withdrawn cannot be maintained for the following reason.

Although a restriction requirement could be made any time before final, the Examiner rendered a first Office action on all the claims which are presumed to be thoroughly searched in all the appropriate areas. And even though the time for making a restriction requirement may be made at any time before final action, 37 CFR 1.42 (a) set forth that "Before making a restriction requirement after the first office action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required", MPEP 811 [R-3]. Referring to the office action dated December 06, 2006, the Examiner failed to set forth any indication of a serious burden if restriction of these claims is not made. Since no indication on the record was made of how a serious burden exists by having to examine all the claims, the Examiner has not met the requirements for making a restriction in this case.

For the reason outlined above, the restriction requirement promulgated and made final is not in accordance with proper Office procedure. Accordingly, the Office action of Mar. 27, 2007 rendered in paper No. 20070319 is hereby withdrawn.

As a further procedural note, as this decision grants Petitioner relief from the restriction requirement, the amendment after final presented June 04, 2007 is deemed responsive to which a new Office action will be rendered. The Examiner should consider doing either re-write a new restriction requirement or adopt the species election as proposed by the applicant in the petition. The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3761 who will have the Examiner promulgate an action on the merits of the presently pending claims not inconsistent with this Decision.

THE PETITION IS GRANTED



Frederick R. Schmidt, Director
Technology Center 3700